



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,079	08/28/2003	Udo Klein	15609-011001 / 2003P00416	7215
32864	7590	12/01/2006	EXAMINER MAHMOOD, REZWANUL	
FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022			ART UNIT 2164	
			PAPER NUMBER	

DATE MAILED: 12/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/650,079	Applicant(s) KLEIN, UDO	
	Examiner Rezwanul Mahmood	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>11222006</u> |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/18/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to the communication filed on September 18, 2006.

Response to Amendment

2. Claims 1-22 are pending in this office action.

In the amendment filed on 09/18/2006, applicant amended independent claims 1, 10, and 19 and dependent claims 11, and 20.

In view of the amendment filed on 09/18/2006, the 35 U.S.C. 112 rejections have been withdrawn.

Claims 1-22 remain rejected under 35 U.S.C. 101.

Response to Arguments

3. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

In view of the applicant's argument regarding the Kaiser reference (US Publication 2005/0010606) used in the 35 U.S.C. 103(a) rejection, the applicant argues that "Kaiser is, and was at the time of the present invention, subject to assignment to the same assignee, SAP AG. As such, 35 U.S.C. 103(c) forbids Kaiser from being usable as a reference to content that the Applicant's claims are obvious."

The examiner responds that there must be a statement provided by the applicant that states the prior art was subject to assignment to the same assignee "at the time the

invention was made.” (See MPEP section 706.02 (I) (1) I)

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The language of the claim raises a question whether the claim is directed merely to an abstract idea that is not tied to a environment or machine which would result in a practical operation producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101.

With respect to claim 1, after the step of “translating the modified directed graph into a modified plurality of timelines that include the modified subset of data records” no tangible result is being produced. The modified plurality of timelines that include the modified subset of data records should be displayed or stored in a storage medium or similar tangible result must be produced by the independent claim to overcome the 35 U.S.C. 101 rejection.

With respect to claim 10, the applicant has amended the claim to specify that the instructions (code segments) on the storage medium are machine-executable. This amendment to the claims still doesn’t make it tangible. To produce a tangible result and to overcome the 35 U.S.C. 101 rejection, “the code segment stored on the storage medium” must be in the body of the claim, not just in the preamble of the claim (i.e. the first code segment stored on the storage medium).

With respect to claim 19, after the step of "means for distributing data associated with the timelines by operating on the directed graph, and thereafter translating the directed graph back into the timelines" no tangible result is being produced. The data should be displayed or stored in a storage medium or electronic database or similar tangible result must be produced by the independent claim to overcome the 35 U.S.C. 101 rejection.

Remarks

5. In the telephonic interview held on November 22, 2006, applicant was informed about the 35 U.S.C. 101 issues in independent claims 1, 10, and 19. Applicant was also suggested to incorporate the same steps (limitations) as claim 1 to independent claims 10, and 19 since they claim similar subject matter. The applicant was informed that after the suggested changes have been made and the 35 U.S.C. 101 issues are overcome, the application could be held in condition for allowance after a new search is performed. Applicant informed that an amendment to the claims will be submitted shortly.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Lystad reference (US Publication 2005/0192783) teaches about translating grouping values into nodes of a directed graph.

Art Unit: 2164

Contact Information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rezwanul Mahmood whose telephone number is (571)272-5625. The examiner can normally be reached on M - F 10 A.M. - 5 P.M..

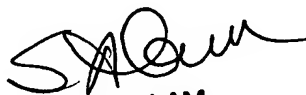
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571)272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Rezwanul Mahmood
Examiner
Art Unit 2164

November 22, 2006



SHAHID ALAM
PRIMARY EXAMINER